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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/224,637 12/31/98 OFEK

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EXAMINER

VITAL, F

ART UNIT

PAPER NUMBER

2186

DATE MAILED:

02/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/224,637

Applicant(s)

Cakeljic et al.

Examiner

Pierre Vital

Group Art Unit

2186



☒ Responsive to communication(s) filed on Dec 4, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on 12/31/98 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

Response to Amendment

2. This Office Action is in response to applicant's communication filed December 4, 2000 in response to PTO Office Action dated July 24, 2000. The applicant's remarks and amendment to the specification and/or the claims were considered with the results that follow.
3. Claims 1-25 have been presented for examination in this application. In response to the last Office Action, claims 1, 14 and 19 have been amended. No claims have been canceled or added. Therefore, the claims remain in the application.
4. The rejection of claims 1-25 as in the Office Action mailed July 24, 2000 (paper number 8) is respectfully maintained and reiterated below for Applicant's convenience.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bingham et al. (US6,052,341).

As per claims 1, 4, 6-9, 11, 13, 14, 16, 17 and 19-23, Bingham et al. teach a method and apparatus that intercepts move or exchange commands from multiple hosts [Col.2, Lines 50-52]; a switching matrix (switched network) for selectively connecting two or more hosts of a set of hosts separately and concurrently (in parallel) to two or more drives (using multiple ports) of a set of drives (primary storage devices) for transferring data between the set of hosts and data storage media (secondary storage device) coupled to the set of drives [Claim 1, Lines 10-14]; an accessor is a robotic device which accesses the data storage media from the storage slots and delivers (automatic transfer of data to storage devices) the accessed media to data storage drives 218 and 219 [Col.4, Lines 64-67].

As per claims 2, 3 and 12, Bingham et al teach a single host tape server system 100 uses an engine 112 to move data between the DASD 116 and tape drives 118 [Col.4, Lines 36-37].

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As per claims 5, 15 and 25, Bingham et al teach at least one accessor (data movers) to access data storage media in the library system and to move data storage media between the bins and the drives [Col.3, Lines 10-12].

As per claims 10, 18 and 24, Bingham et al teaches a virtual tape server (VTS) having a tape library has been proposed [Col.1, Lines 26-27].

Response to Arguments

7. Applicant's arguments filed December 4, 2000 have been fully considered but they are not persuasive. As to the remarks, Applicant asserted that:

- (a) the prior Office Action does not state that a new oath or declaration is required;
- (b) Bingham does not anticipate the present invention because Bingham does not disclose a plurality of primary storage devices coupled to a switched network together with a secondary storage device;
- (c) Bingham does not anticipate the present invention because Bingham does not disclose a switched network to connect the drives to the physical storage media.

Examiner respectfully traverses Applicant's remarks for the following reasons:

With respect to (a), Examiner agrees with Applicant that the prior Office Action does not state that a new oath or declaration is required. Examiner apologizes for the confusion. However, Examiner would like to point out that because the oath/declaration does not identify the post office address of each inventor, a new oath or declaration is required. If the Applicant's post

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office address is same as Applicant's residence, Applicant should specify it in the oath/declaration as follows:

Post Office Address: same as residence.

With respect to (b) and (c), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., primary storage devices coupled to a switched network together with a secondary storage device; a switched network to connect the drives to the physical storage media) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner would like to emphasize that the system disclosed by Bingham is the same as that claimed by Applicant. Bingham clearly discloses a switched network coupled to a plurality of primary storage devices and to a secondary storage device in column 1, lines 44-46 and column 3, lines 6-8.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre M. Vital whose telephone number is (703) 306-5839. The examiner can normally be reached on Monday to Friday from 8:30 A.M. to 6:00 P.M., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim, can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.


MK/pmv

January 25, 2001


MATTHEW KIM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100